

1764/13

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C., 20231, on the date indicated below.

BY: Arthur Shnell

DATE: April 1, 2003



Patent
Box Non-Fee Amendment

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re:	Patent Application of HIDEO YOKOTA <i>et al.</i>	: Group Art Unit: 1764
Conf. No.:	9376	:
Appln. No.:	09/891,486	: Examiner: Ellen McAdams
Filed:	June 25, 2001	:
For:	CUTTING OR GRINDING OIL COMPOSITION	: Attorney Docket : No. 8305-210US : (NP102-1)

RECEIVED
APR 09 2003
GROUP 1700

REQUEST FOR NEW OFFICE ACTION

This Request is being filed in reference to the Office Action dated March 17, 2003 (Paper No. 12).

Applicants hereby request a new Office Action in view of the fact that Paper No. 12 is non-responsive to Applicants' RCE Request and Accompanying Amendment. Specifically, when responding to a communication from an applicant, the Examiner should answer all of the material traversed. In particular:

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. (M.P.E.P § 707.07(f)).

Although the cover page of the Office Action indicates that Paper No. 12 has been issued in response to the Amendment filed on March 10, 2003, the Examiner has not responded to nor addressed the amendments and arguments filed on that date. Rather, the Examiner has merely withdrawn finality in response to the filing of a Request for Continued Examination, and then repeated verbatim all of the previous rejections and arguments from the Office Action mailed October 4, 2002.

More specifically, the Examiner has rejected the claims under 35 U.S.C. 103(a) as being unpatentable over two proposed combinations of references: Koyama in view of Ott and Zielinski in view of Ott. The Examiner's arguments supporting the rejection based on Koyama are identical to those provided in the previous two Office Actions. Regarding the rejection based on Zielinski in view of Ott, the Examiner has merely added that the intended use language carries little if any weight in the claims since it does not further limit the composition. However, the Examiner has not responded to Applicants' arguments regarding the lack of motivation for combining Zielinski and Ott, nor the deficiencies in both Zielinski and Ott regarding the claimed kinematic viscosity of the composition.

Additionally, it is noted that in the final Office Action dated October 4, 2002 (Paper No. 9), the Examiner also did not respond to Applicants previous arguments, filed June 26, 2002, regarding the differences between the claimed invention and the cited prior art. Rather, the Examiner merely indicated that the arguments "have been fully considered but are not persuasive" and made the Office Action final. The Examiner thus did not fulfill her burden of "in a final office action... the final rejection... should include a rebuttal of any arguments raised in the applicants' reply" (MPEP 706.07). **Accordingly, since the Examiner has now failed twice to respond to Applicants' detailed arguments, Applicants are unable to advance the prosecution of the present application.**

Further, the Examiner has not addressed Applicants' demonstration of unexpected results of the claimed compositions, which were presented in the Amendment filed March 10, 2003. As required by MPEP 707.07(f),

If it is the examiner's considered opinion that the asserted advantages are not sufficient to overcome the rejection(s) of record, he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of

Patent Appeals and Interferences will also be advised. The importance of answering applicant's arguments is illustrated by *In re Herrmann*, 261 F.2d 598, 120 USPQ 182 (CCPA 1958) where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable.

Accordingly, Applicants respectfully request that the Examiner address Applicants' unexpected results on the record.

In conclusion, since Applicants' amendments, arguments, and data have not been addressed, the outstanding Office Action is non-responsive and improper. A new Office Action is respectfully requested.

Respectfully submitted,

HIDEO YOKOTA ET AL

April 1, 2003
(Date)

By:

Sandra M. Katz
SANDRA M. KATZ

Registration No. 51,864

AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.

One Commerce Square

2005 Market Street - Suite 2200

Philadelphia, PA 19103-7086

Telephone: (215) 965-1200

Direct Dial: (215) 965-1344

Facsimile: (215) 965-1210

E-Mail: skatz@akingump.com

WWS:SMK:smk